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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,214	12/05/2003	Gregory T. Huber	S9025.0330	2468
63725	7590	08/27/2008		
DICKSTEIN SHAPIRO			EXAMINER	
1177 AVENUE OF THE AMERICAS (6TH AVENUE)			LSTVOYB, GREGORY	
NEW YORK, NY 10036-2714				
		ART UNIT	PAPER NUMBER	
		1796		
		MAIL DATE	DELIVERY MODE	
		08/27/2008	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/730,214

Applicant(s)

HUBER ET AL.

Examiner

GREGORY LISTVOYB

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 2-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 11-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date 3/4/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of polymeric dispersant in the reply filed on 5/20/2008 is acknowledged. The traversal is on the ground(s) that the initial claim in the set of withdrawn claims encompasses all of the alternatives of preparation method such as imidization with or without catalyst, in solution or in bulk, with chemical or thermal imidization, etc. This is not found persuasive because for instance, claim 2 teaches mixing of the components at temperature, sufficient for catalyzing the reaction. Therefore, Claim 2 teaches the process with catalyst. In addition, according to the Claim 2 and Example 1 of the Specification, ingredients of the reaction mixed in the bulk, i.e. without solvent.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 contains the trademark/trade name BONA lacked pigments. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe BONA lacked pigments and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 rejected under 35 U.S.C. 102(b) as being anticipated by Franz et al (US 4859210) herein Franz.

Franz teaches dispersant, which is a reaction product of trimellitic (1,2,4-benzenetricarboxylic anhydride) (see column 5 line 30) and polyisobutylamine (see Column 5, line 40).

Franz does not teach that the above condensate is a polyimide.

However, at the reaction conditions (heating at 180C for 6 hours), which is comparable with the ones of the Application (heating at 140C for 4 hours) the imide ring is inherently formed.

Note that Franz uses his polyisobutylamine in combination with polyisobutyl alcohol. Therefore, in addition to polyimide, polyester is also formed. However, open language of claim 1 (i.e. "comprising") does not prohibit the presence of other reagents and resulting products in the reaction mixture.

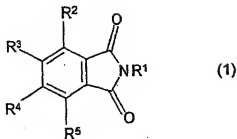
Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 11-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Winter et al (WO 02/0234840, cited with equivalent US 6821335) herein WO 02/34840 in combination with Patil et al (US 5633326) herein Patil .

Winter teaches a pigment dispersant with the following formula:



where

R¹ stands for a straight-chain, branched or cyclic aliphatic radical having 10 to 30 carbon atoms; for an alkenyl radical having 10 to 30 carbon atoms.

R², R³, R⁴ and R⁵ are identical or different and denote hydrogen, C₁-C₁₀ alkyl, C₁-C₁₀ alkoxy, halogen, -OR₆, -NR₆R₇, -COOR₆, -CONR₆R₇, "NR₆" COR₇, SO₂NR₆R₇, -SO₃M, -NO₂, -CN or CF₃, R₆ and R₇ standing for H or an alkyl radical having 1 to 10 carbon atoms and M standing for one equivalent of a 1 to 3 valent cation.

Therefore, when R², R⁴ and R⁵ radicals are Hydrogens and R³ is COOR₆, where R₆ is Hydrogen, the formula above represents imide based on 1,2,4-benzenetricarboxylic anhydride.

WO 02/34840 discloses a polyalkyl benzimide polymeric dispersant for use in printing ink compositions, comprising the reaction product of a polyalkylene amine with up to C₃₀ aliphatic chain with phthalic anhydride (see Claim 1), where colorant dispersion comprising at least 45%wt (5-60%wt), 0.1-15% of the dispersant (see

Column 3, line 20, meeting the limitations of claims 18-19) and having viscosity lower than 150Pas.

Note that WO 02/34840 does not teach viscosity of the dispersion, having at least 45% of colorant. However, data, presented in Tables (see Column 9 and 10) show that viscosity value at 35% of pigment content is 209 mPa, which is 0.209Pa. Therefore, it would have been obvious to an artisan that viscosity at 45% of colorant would not exceed 150Pa.

Note that WO 02/34840 does not teach a reaction product of polyisobutylene (PIB).

PIB is a branched aliphatic compound of a formula: $(C(CH_3)_2-CH_2)_n$

Winter teaches a straight-chain, branched or cyclic aliphatic radical having 10 to 30 carbon atoms (see R1 above). Therefore, disclosure of Winter encompasses the definition of PIB (In other words, Winter's disclosure may include PIB as a branched alkyl chain with up to 30 carbon atoms).

Polyisobutylene oligomer used in the Application examined has Mn more than 500, which is comparable with C30 alkylene chain disclosed in WO 02/0234840 (at 30 carbons molecular weight of the alkyl chain is equal to 420-450 Daltons, depending on branching. In addition, molecular weight of PIB is not defined in the Claims).

Therefore, the above ingredients are homologs. In accordance to MPEP 2144.09 the

structural analogs are *prima facie* obvious in the absence of showing unexpected results.

In addition, Patil teaches a dispersant, based on polyisobutylene succinimide(see Column 13, line 50 and Column 3, line 30).

Patil teaches that the above polymer has very good dispersing properties in wide variety of environment (Column 24, line 45). In addition, due to a presence of tert-butyl group, PIB possesses antioxidant properties.

Therefore, it would have been obvious to a person of ordinary skills in the art to replace C30 alkyl to PIB in WO 02/34840 in order to enhance dispersing properties and increase resistance to oxidation of the composition.

Regarding Claims 13-15, WO 02/34840 discloses laked organic pigments, such as naphthol pigments (Column 3, line 5).

In reference to Claim 16, WO 02/34840 does not disclose pigments listed in the claim. However, WO 02/34840 teaches the following examples of organic pigments in the sense of the invention are monoazo pigments, disazo pigments, disazo condensation pigments, laked azo pigments, triphenylmethane pigments, thioindigo pigments, thiazine indigo pigments, perylene pigments, perinone pigments, anthanthrone pigments, diketopyrrolopyrrole pigments, dioxazine pigments,

quinacridone pigments, phthalocyanine pigments, isoindolinone pigments, isoindoline pigments, benzimidazolone pigments, naphthol pigments and quinophthalone pigments, preference being given to anthanthrone pigments, dioxazine pigments, and phthalocyanine pigments, and also acid to alkaline carbon blacks from the group of the furnace blacks or gas blacks.

Examples of Suitable inorganic pigments are titanium dioxides, zinc sulfides, iron oxides, chromium oxides, ultramarine, nickel and chromium antimony titanium oxides, cobalt oxides, and bismuth vanadates.

The position is taken that the above pigments encompass the ones listed in the claim 16.

Regarding Claim 17, WO 02/34840 does not disclose 65% colorant present. WO 02/34840 teaches 5-60% wt of colorant.

In the relevant case law (see *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985), where Claims to titanium (Ti) alloy with 0.8% nickel (Ni) and 0.3% molybdenum (Mo) were not anticipated by, although they were held obvious over, a graph in a Russian article on Ti-Mo-Ni alloys in which the graph contained an actual data point corresponding to a Ti alloy containing 0.25% Mo and 0.75% Ni. (see also MPEP 2131.03).

Therefore, it would have been obvious to a person of ordinary skills in the art to increase colorant load in WO 02/34840 to 65%wt , make the composition more economically efficient.

Regarding Claims 21, WO 02/34840 discloses broad range of applications, such as colorants for electrophotographic toners, sprayable colorants. It is cover variety of shapes and materials, such as glass, ceramic, concrete, etc. Therefore, the above composition is applicable as lithographic printing ink.

Response to Arguments

Applicant's arguments filed on 5/20/2008 have been fully considered but they are not persuasive.

Regarding rejection under 35 USC 112(2), Examiner disagrees that BONA's definition is immediately clear to an artisan. Therefore, rejection of claim 15 sustains.

Regarding Claim 16, Examiner agrees with the Applicant that designations Red 49, etc, are the approved Color Index names for the particular pigments and does not represent trademark or tradename. Thus, the rejection, based on US 35 USC 112(2) of Claim 16 is withdrawn.

Regarding rejection under 35 USC 103(a) Applicant argues that the dispersant of the present invention, however, is a reaction product of a polyisobutylene amine with

1,2,4-benzinetricarboxylic anhydride. There is no mention of either of these reactants in the Winter reference.

This is incorrect. Winter's formula encompasses 1,2,4-benzinetricarboxylic anhydride and branched alkyl fragment encompasses polyisobutylene.

Arguments regarding Waters reference are moot, since the reference is withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY LISTVOYB whose telephone number is (571)272-6105. The examiner can normally be reached on 10am-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rabon Sergent/
Primary Examiner, Art Unit 1796

GL